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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Armonds Manufacturing Company, Inc.

Serial No. 74/689,088

Dorian B. Kennedy of Kennedy & Kennedy for applicant.

Raul F. Cordova, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Rice, Seeherman, and Hairston, Administrative
Trademark Judges.

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by Armonds Manufacturing
Company, Inc. to register, on the Principal Register
pursuant to the provisions of Section 2(f) of the Trademark
Act of 1946 ("Act"), 15 U.S.C. §1052(f), the configuration
shown below (in reduced size)

for toothpicks.¹ It is stated in the application that the mark consists of the configuration of a toothpick, and that the lining is not a feature of the mark and does not indicate color, but rather is to indicate depth of the mark.

Registration has been finally refused, under Sections 1, 2, and 45 of the Act, 15 U.S.C. §§1051, 1052, and 1127, on the alternative grounds that applicant's configuration is de jure functional and hence unregistrable; or, if the configuration is not de jure functional, that it is de facto functional, is not inherently distinctive, and has not acquired distinctiveness as an indication of origin for applicant's goods. Applicant has appealed. Both applicant and the Examining Attorney have briefed the issues before us. An oral hearing was not requested.

We turn first to the refusal to register on the ground that applicant's toothpick configuration is de jure functional. A configuration which is so utilitarian as to constitute a superior design for its purpose, so that competitors need to copy it in order to compete effectively, is de jure functional (functional in law), and unregistrable. The mere fact that a product configuration

¹ Application Serial No. 74/689,088, filed June 15, 1995, claiming first use and first use in commerce on April 5, 1990.

has utility does not necessarily mean that the configuration is unregistrable; registrability depends upon the degree of its design utility. See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15 (CCPA 1982). If a product is in its particular shape because it works better in that shape, the configuration of the product is de jure functional. See *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3. (Fed. Cir. 1984). Factors which are relevant to the determination of whether a particular product design is superior include (1) the existence of a utility patent that discloses the utilitarian advantages of the design, (2) advertising materials in which the originator of the design touts the design's utilitarian advantages, (3) the availability to competitors of alternative designs, and (4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product. See *In re Morton-Norwich Products, Inc.*, *supra*.

With respect to the first factor, the Examining Attorney has made of record both a utility patent and a design patent, each of which issued to a different third party.² The utility patent (No. 4,314,574, issued February

² The utility patent was made of record as evidence that applicant's configuration is de jure functional. The design

9, 1982) is for an invention entitled "TOOTH-PICK HAVING ONE FOLDED END AND ASSOCIATED POCKET CONTAINER BOX." There are two full-length drawing figures of the toothpick, as shown below:³

The portion of the abstract pertaining to the toothpick reads: "Tooth-picks formed by a straight central portion of constant thickness, an end with a sharp point or tip, another end with a section angled at about 45° with thickness tapering to the tip, which is transversally rounded."⁴ The first listed advantage of the toothpick

patent was offered as evidence that the configuration lacks distinctiveness.

³ According to the patent, FIG. 1 is "a side, plan and sectional view showing the tooth-pick" and FIG. 2 is "a plan view thereof."

⁴ The claim relating to the toothpick reads:

A laminar toothpick comprising a straight central portion of a constant thickness, terminating at one end in a sharp point, while the other end is angular, lying in the same plane but disposed at about 45° to the axis of said central portion, said point and said angular end being integral with said central portion, said angular end having adjacent the first portion the same thickness as the central portion, but then immediately tapering, toward the tip, and terminating in a rounded edge.

reads: "The inclined or angled section allows an easy access to all of the tooth interstices, thus obtaining an improved cleaning of the oral cavity."⁵ The next listed advantage reads: "The least tapered end is intended for the intertooth spaces, while the pointed or sharpened end of the opposite end, which is of constant thickness, is more useful adjacent the tooth neck or on the occlusal surfaces."

This utility patent indicates that the angled section of applicant's toothpick configuration constitutes a significant utilitarian advantage in that it allows easy

⁵ The background of the invention reads as follows:

This invention relates to a tooth-pick having one angled end and an associated pocket container.

Tooth-picks are commonly known, as mostly made of wood or plastics material, having round, square or plain or flat section, but provided with the two ends that are mirror-like the same relative to a plane perpendicular to the single longitudinal axis of symmetry.

Some of such tooth-picks are characterized by being provided with a sharp point or tip, and others by having a rounded point or tip.

A tooth-pick according to the present invention combines the advantages of both of the above mentioned types but with the added novelty of having one end thereof angled, so as to be of asymmetrical shape, with one end of prevailing pointed configuration and the other end of prevailing rounded configuration, but with a blade thickness.

The cross-section may be rectangular with sharp edges or chamfered edges; it is of constant thickness towards the sharpened point or tip, while gradually decreasing to the opposite end with a resulting tapering, promoting entry into the intertooth space.

access to all of the spaces between the teeth. The background portion of the patent, as quoted in footnote 5 above, also indicates that a square shaft and sharp points or tips are common features of toothpicks. Obviously, the pointed ends are a standard utilitarian toothpick feature; they facilitate the removal of food from between and around the teeth.⁶ The square shaft is one of the few basic shapes for toothpick shafts. Thus, it appears from the information in the patent that except for the angled end, which constitutes a significant utilitarian advantage, applicant's toothpick design does not differ substantially from conventional toothpick designs.

The existence of this utility patent is strong evidence of the de jure functionality of the configuration. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985), and *In re Morton-Norwich Products, Inc.*, *supra*. Applicant argues, however, that the design patent made of record by the Examining Attorney is evidence that applicant's toothpick design is not de jure functional,

⁶ Attached to the Examining Attorney's appeal brief is a copy of a page from the Random House Compact Unabridged Dictionary (Special Second Edition, 1996) showing that the noun "toothpick" is defined therein as "a small pointed piece of wood, plastic, etc., for removing substances, esp. food particles, from between the teeth." Although this dictionary definition was not made of record by the Examining Attorney prior to appeal (see Trademark Rule 2.142(d), 37 CFR §2.142(d), we can and hereby do take

because "a design patent cannot be granted or can be invalidated by the establishment of functionality."⁷

The design patent (No. 345,825) is for the ornamental design of a toothpick, as shown below (in reduced size):

It is true that the existence of a design patent is some evidence of nonfunctionality. However, it is not conclusive evidence thereof. See *In re R.M. Smith, Inc.*, *supra*; *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1842 (TTAB 1997); and *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989). Here, we are of the opinion that the evidence of the design patent is outweighed by the evidence of the utility patent.⁸ Cf. *In re Caterpillar Inc.*, *supra*.

We turn next to the second factor, i.e., the existence of advertising materials in which the originator

judicial notice of the definition. See *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994).

⁷ Applicant's appeal brief, page 4.

⁸ While applicant's toothpick design and the toothpick design in the design patent are similar to the extent that both have one angled end, there are also differences between them, as, for example, in the shape of the shaft and the other end.

of the design touts the design's utilitarian advantages. In response to the Examining Attorney's request for submission of "any available advertising, promotional or explanatory material concerning the goods, particularly any material specifically related to the feature embodied in the proposed mark," applicant stated that it does not advertise the goods but instead sells them to large retail chain stores, and to the military for resale in PX's and commissaries. Applicant did submit some examples of its packaging. An example thereof is shown below:

Although this packaging certainly calls attention to the angled end of applicant's toothpick configuration, and refers to the "Professional Design," it does not really tout the utilitarian advantages of the shape of the toothpick.

As to the third and fourth factors, i.e., the availability to competitors of alternative designs, and whether the applicant's design results from a comparatively simple or cheap method of manufacturing the product, applicant has submitted the declaration of its president, Mr. Armond O. Parks, Jr. Mr. Parks states, inter alia, that toothpicks have been or are presently made in many different shapes and configurations which are different from the configuration sought to be registered, and that these alternative toothpicks are equally or less costly to produce than the subject toothpick. In support of its argument that today there are a multitude of alternative toothpick designs, none of which has a bend, applicant has submitted evidence relating to three other toothpick designs on the market.⁹ The evidence consists of

⁹ It appears from the photographs submitted by applicant that two of the alternative designs (the DR. DU-MORE'S PLAQ-U-PICK plaque remover and the STIM-U-DENT plaque remover) are very similar to one another, that is, that they are simply slight variations of the same basic design.

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photographs showing each of the toothpicks and the
packaging therefor, as shown below:

We have no reason to doubt Mr. Park's declaration that the alternative toothpick designs are equally or less costly to produce than applicant's toothpick. However, applicant's design has a utilitarian advantage over the alternative designs, all of which are straight, in that the angled end of applicant's toothpick allows easier access to all of the tooth interstices. Applicant's evidence does not persuade us that there are competitive designs that are functionally equivalent to applicant's design.

Given the evidence provided by the utility patent and the lack of alternative designs allowing equally easy access to all of the tooth interstices, we conclude that applicant's overall design is a superior design for its functional purpose; that it is in its particular shape because it works better in that shape; and that it is, therefore, *de jure* functional.

For the sake of completeness, in case our finding of *de jure* functionality should be reversed on appeal, we turn to the issues of whether, if applicant's design is only *de facto* functional, it is either inherently distinctive or, if not, has acquired distinctiveness.¹⁰

¹⁰ In response to the refusal to register, applicant filed an amendment seeking registration under the provisions of Section 2(f) of the Act, claiming that its design has become distinctive of its goods in commerce. However, applicant has consistently taken the position that its design is inherently distinctive, and

In determining whether a design is inherently distinctive, the Court of Customs and Patent Appeals, the predecessor of our reviewing court, the Court of Appeals for the Federal Circuit, has considered such factors as whether is it "a 'common' basic shape or design," whether it is "unique or unusual in a particular field," or whether it has an "original, distinctive, and peculiar appearance." See *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977), and *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960), quoting with approval from *Ex parte Haig & Haig, Ltd.*, 118 USPQ 229, 230 (Asst. Comm. 1958). In the present case, the patent and dictionary evidence made of record by the Examining Attorney convinces us that applicant's configuration is not so original or unusual in appearance that it would inherently be perceived as a trademark. Cf. *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992), and *In re Usher, S.A.*, 219 USPQ 920 (TTAB 1983).

This brings us, finally, to the question of whether the evidence submitted by applicant is sufficient to make out a prima facie showing that its design has become distinctive of its toothpicks in commerce. In support of

that the Section 2(f) claim is to be considered only in the event that its design is found to be not inherently distinctive. Thus,

its claim of acquired distinctiveness, applicant again relies upon the declaration of Mr. Parks. The declaration states, in relevant part, that applicant's subject toothpick has been sold since 1990; that during the period from 1990 until October 22, 1997 (the date the declaration was signed), the number of toothpicks sold by applicant throughout the United States totalled approximately 12,260,077,760 (or approximately 122,600,777 boxes holding 100 toothpicks per box); that as a form of promoting the subject toothpick, applicant has provided retailers approximately 10% of its production free of charge for use in floor displays, restaurant promotions and slotting sales; and that the United States government has recently placed applicant's toothpick on the list of items which must be carried in all military base PX's and commissaries.

In addition, the declaration states that applicant's packaging focuses on the angled feature of its toothpicks, in that the mark thereon includes the term ANGLED together with a depiction of an angled toothpick.¹¹ An example of

we treat the Section 2(f) claim as being an alternative position. See TBMP §1215.

¹¹ The declaration also states that applicant's "toothpick has been the subject of newspaper articles recognizing the unique shape of the toothpick," and specifically identifies three newspaper issues in which such articles have allegedly appeared, namely, "Florida Grocer, July 1990, Athens Daily News, November 25, 1991 and Athens Banner Herald, November 25, 1991." However, applicant failed to submit copies of the articles. Without

applicant's packaging is shown above, in connection with the second de jure functionality factor. For ease of reference, that example is shown again here, along with the two others submitted by applicant:

copies of the articles, we cannot tell whether they demonstrate recognition of the toothpick shape as a mark, or instead serve as evidence of the de jure functionality of the shape, or are ambiguous.

Counsel for applicant states, in applicant's appeal brief, that the toothpick design has recently been identically copied by applicant's former distributor, Mack F. Blevins; that applicant has filed a civil action against Mr. Blevins in the Northern District of Georgia, Atlanta Division (Armonds Manufacturing Company v. Mack F. Blevins 1:97-CV-3194-CC); and that proof of intentional copying is considered to be a factor in determining secondary meaning. No copy of the pleadings in the civil action was submitted. In a paper entitled "SUBMISSION OF SUPPLEMENTAL BRIEF" filed November 16, 1999, counsel for applicant asserts that on the second day of trial, Mack Blevins agreed to a license and a consent judgment in applicant's favor. No copy of the consent judgment was submitted. There is no provision for the filing by an applicant of a "supplemental brief" such as this, though an applicant may file a request to suspend and remand for consideration of new evidence. See Trademark Rule 2.142(d), 37 CFR §2.142(d). In any event, the filing of the civil action, and the resulting consent judgment, do not establish the validity of applicant's configuration as a trademark. Indeed, while counsel for applicant argues, in effect, that the copying by Blevins was an attempt by him to benefit from the good will and reputation built up by applicant with respect to the configuration, the copying of a configuration may be an indication that competitors need to use the shape because it is functionally superior, and a consent judgment may show the desire of a competitor to avoid the expenses of litigating a case to a decision on the merits. Cf. *In re Wella Corp.*, 635 F.2d 845, 196 USPQ 7 (CCPA 1977). The civil action does, however, demonstrate applicant's policing

Applicant's letterhead similarly features the shape of its
toothpick, as shown below:

efforts with respect to the configuration sought to be
registered.

As the Examining Attorney notes, large sales figures alone do not necessarily indicate that a particular configuration has come to be viewed by purchasers as a trademark. Often, such sales figures simply indicate the success or popularity of the product. However, applicant's sales figures have to be viewed in conjunction with applicant's packaging, which prominently features applicant's toothpick configuration, both as part of a composite trademark and also by itself (at the bottom of the blister pack). Moreover, the term ANGLED in applicant's composite mark also calls attention to the shape of the toothpick. Considering the many millions of packages of toothpicks sold by applicant, together with the nature of the use made on applicant's packaging, and the length of use of the configuration, we are persuaded that applicant has made out a prima facie case of acquired distinctiveness.

Decision: The refusal to register on the ground that applicant's configuration is de jure functional is affirmed; the alternative refusal to register on the ground that the configuration is de facto functional and is not inherently distinctive is also affirmed; but the alternative refusal to register on the ground that the configuration has not acquired distinctiveness is reversed.

J. E. Rice

E. J. Seeherman

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
And Appeal Board

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